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Barry R Lipsitz
755 Main Street
Bldg 8
Monroe, CT 06468

EXAMINER	
TRAN, DOUGLAS Q	

ART UNIT	PAPER NUMBER
2624	24

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/688,475	KEENEY ET AL.	
	Examiner	Art Unit	
	Douglas Q. Tran	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-96* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-96* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-4, 6, 12-34, 39-45, 46-49, 51,57-79, 84-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Motegi (US Patent No. 6,307,640) and Savitzky (US Patent No. 6,012,083) and Ikeda (JP 2000155733 A).

As to claim 1, Motegi teaches a method of receiving, storing, and forwarding a print job over a network, comprising:

forwarding the print job to a spooling server (i.e., the host computer 113 in fig. 1) (col. 2, lines 57-60: the network computer forwarding the print jobs from computers to the host computer 113);

receiving and storing the print job at the spooling server (the host computer stores the print jobs from the users 101 to 104 until requesting from the user in step of S2 in fig. 3);

receiving an instruction at the spooling server to initiate the print job for printing at a designated printer (the selected printer is controlled by the user "col. 2, lines 60-62". Therefore, the print job including the designated printer setting is sent by the user; and the print job is initiated by the host computer with the password to the user, the user does not assign the password col. 3, lines 19-24);

initiating the print job for printing in response to the instruction (the host computer provide the confidential information by providing the password to the print job "col. 3, lines 48-50");

receiving a polling request for the initiated print job at the spooling server from a printer (i.e., a printer 107 in fig. 1) via a printer-polling device associated with the designated printer (col. 3, lines 33-37: the print server sends the polling request by the printer for the initiated print job to the host computer);

forwarding the request initiated print job from the spooling server to the printer-polling device in response to the polling request from the printer (col. 3, lines 3, lines 51-52).

However, Motegi does not explicitly teach a computer requests for a document file from the spooling server (i.e., the host computer).

Savitzky, in the same field of endeavor, teaches a computer (i.e., client A) in the network requests for a document file from the spooling server (i.e., the agency 32 in fig. 3) and receives the requested document from the agency (i.e., client A is recipient who sends the document requests, col. 10, lines 33-34 and 51-52).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the communication network of Motegi in order for the print server computer to request and receive the requested document from the agency 32 as taught by Savitzky. The suggestion for modifying the communication system of Motegi can be reasoned by one of ordinary skill in the art as set forth by Savitzky because the modified printing system of Motegi increase the flexibilities of the communication between the host computer and the printer

server and the printer so that not only the printer but also the printer server can request the document file from the host computer.

However, neither Motegi nor Savitzky teach of polling request being automatically forward from the printer polling device to the spooling server.

Ikeda teaches of polling request being automatically forward from the printer polling device to the spooling server (please see the solution).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the communication network of Motegi and Savitzky in order for the computer to poll request being automatically forward from the printer polling device to the spooling server as taught by Savitzky. The suggestion for modifying the communication system of Motegi and Savitzky can be reasoned by one of ordinary skill in the art as set forth by Ikeda because the modified printing systems increase the efficiencies of the communication between the host computer or the printer and the printer server for exchanging the signal automatically, and so that not only the printer but also the computer can automatically request the document file or the print job from the server.

As to claim 2, Motegi teaches that the print job is printed at the designated printer (i.e., 107 in fig. 1) coupled to the printer-polling device (col. 3, lines 33-37).

As to claim 3, Savitzky teaches that the printer is located at a location remote from the spooling server (see fig. 5).

As to claim 4, Savitzky teaches that the print job is forwarded to the spooling server without a pre-determined print destination (with this condition, the print job is treated as a

document with a transferred document format 66 in fig. 5 without a command data for instructing the printing at the suitable printer).

As to claim 6, Savitzky teaches that the network comprises: at least one of LANs, a WAN, a global network, and the Internet (col. 1, lines 12-17).

As to claim 12, Savitzky teaches that the spooling server is capable of storing multiple print jobs in at least one spooling queue (col. 6, line 28).

As to claim 13, Savitzky teaches that providing for encryption of the print job at a print job source; and providing for decryption of the print job at the printer-polling device (col. 14, lines 25-26).

As to claim 14, Savitzky teaches that the print job comprises a document provided by a content provider (col. 10, lines 36-39).

As to claim 15, Savitzky teaches that the content provider is one of a newspaper, a magazine, a periodical, a document provider, a graphic arts provider, a notification service, an Internet content provider, a merchant, a financial institution, a government agency, or a shipping company (66 in fig. 5, col. 49-52).

As to claim 16, Savitzky teaches that a single print job is provided by the content provider for multiple users (12 in fig. 1).

As to claims 17-18, Savitzky teaches that the print job is provided by the content provider on a subscription basis and a fee is charged to access the spooling server (i.e., the transaction, col. 10, lines 39-42).

As to claim 19, Savitzky teaches that storing each print job at the spooling server according to a personal identification number (PIN) (col. 12, lines 17-19).

As to claim 20, Savitzky teaches that communicating from the spooling server to the printer polling device a list of print jobs associated with the PIN which are stored at the spooling server; and providing for the selection of a print job (col. 12, lines 17-19).

As to claim 21, Savitzky teaches that storing a plurality of print jobs on the spooling server according to the PIN (col. 12, lines 17-19).

As to claim 22, Savitzky teaches that the PIN is provided to the spooling server via one of a user interface associated with the printer polling device, a telephone, a computer, an Internet appliance, a facsimile machine, a scanner, a personal digital assistant device, or a dedicated terminal; The list of available print jobs is displayed on one of a user interface associated with the printer polling device, a telephone, a computer, an Internet appliance, a facsimile, a scanner, a personal digital assistant device, or a dedicated terminal (table 1 in col. 6).

As to claim 23, Savitzky teaches that providing for designation of a desired print location for the print job at a print job source; providing for communication of the desired print location to the spooling server; printing the print job at the desired print location when the printer polling device at the desired print location polls the spooling server and identifies the print job (see fig. 5 and col. 13, lines 1-2).

As to claims 24-26, Savitzky teaches that providing for designation of a substantially specific time for printing a print job; making the print job available for printing from the spooling server only at the designated substantially specific time; providing for a designated lifetime of the print job, wherein the print job will be stored only for the designated lifetime; providing for a designated number of printings of the print job, wherein the print job can only be

printed the designated number of times (the options which allow the clients control the print job).

As to claim 27, Savitzky teaches that the print job is one of a negotiable instrument, a stamp, a coupon, a certificate, a check, a unit of currency, a token, or a receipt (66 in fig. 5).

As to claim 28, Savitzky teaches that providing for the designation of one or more recipients of the print job, wherein the print job can only be printed by the designated one or more recipients (20 in fig. 1).

As to claim 29-33, Savitzky teaches that the printer polling device communicates printer status to the spooling server; the printer status comprises at least one of a printer ready indication, an online indication, toner level information, paper supply information, or error information; notifying a printer operator when the printer status indicates that the printer requires attention; providing the operator with vendor contact information to facilitate obtaining printer supplies or service; providing for automatic on line ordering of printer supplies as required by printer status (col. 13; lines 25-28).

As to claim 34, Savitzky teaches that the print job comprises at least one of a document, a poster (66 in fig. 5).

As to claim 39, Savitzky teaches that communications with the spooling server are enabled via at least one of a telephone, a personal digital assistant device, a computer, an Internet appliance, a web browser, or a dedicated terminal (18 in fig. 1).

As to claim 40, Savitzky teaches that providing a communication device for providing the status of the print job stored on the spooling server (col. 3, lines 58-64).

As to claim 41, Savitzky teaches that the status of the print job comprises at least one of filename , file size, author, creation date, print job lifetime, image, title, contents, personal id, recipient, job number, or reference number (col. 3, lines 45-52).

As to claim 42, Savitzky teaches that the communication device comprises one of a telephone, a computer, an Internet appliance, a personal digital assistant device, or a dedicated terminal (10 in fig. 1).

As to claim 43, Savitzky teaches that the print job source is one of a computer, a persona digital assistant device, an Internet appliance, a facsimile, a scanner, a telephone, or a dedicated terminal (12 in fig. 1).

As to claim 44, Savitzky teaches that the printer-polling device is capable of polling multiple spooling servers (14 in fig. 1).

As to claim 45, Savitzky teaches that providing for the communication between the spooling server (10 in fig. 1) and other servers (14 in fig. 1); and receiving a print job from at least one of the other servers at the spooling server (col. 5, lines 6-8).

As to claim 91, Motegi teaches the instructions are forwarded from an interface associated with a print job source together with the print job (col. 2, lines 57-59).

As to claim 92, Motegi teaches the instructions are forwarded from an interface remote from a print job source and remote from the printer-polling device (col. 2, lines 57-62).

As to claim 93, Motegi teaches the instructions are forwarded from an interface associated with the printer-polling device (col. 2, lines 63-65: the desired printer would associated with the printer polling device "col. 3, lines 33-37).

As to claims 46-49, 51,57-79, 84-90 and 94-96, the combination of Motegi, Savitzky and Ikeda teaches the apparatus for performing the method claims 1-4, 6, 12-34, 39-45 and 91-93 as indicated above.

3. Claims 5, 35-38, 50 and 80-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Motegi, Savitzky and Ikeda, in view of claims 1 and/or 46, and Newton et al. (US Patent No. 6,334,142 B1).

As to claim 5, Motegi and Savitzky teach every feature in claim 1 as indicated above.

However, neither Motegi nor Savitzky nor Ikeda teach the printer-polling device periodically polls the spooling server to identify print jobs associated with the printer-polling device.

Newton, in the same field of endeavor, teaches the printer polling device periodically polls the spooling server to identify print jobs associated with the printer polling device (col. 1, lines 48-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the communication system of either Motegi or Savitzky or Ikeda for periodically polling the spooling server to identify print jobs associated with the printer polling device as taught by Newton. The suggestion for modifying the communication system of Motegi, Savitzky and Ikeda can be reasoned by one of ordinary skill in the art as set forth by Newton because Newton teaches communication devices relates to supplying messages on the purpose of keep tracking documents on the network by transmitting requests automatically at periodic intervals to the server from the first computer for messages from another computer.

As to claims 35-37, Newton teaches that providing an agent program that provides a directory of documents (the messages are stored on the server as files) to the spooling server, the agent program enabling a client device associated with the print job source to poll the spooling server to determine whether the spooling server requires a document from the directory to complete a print job; and uploading the document from the client device to the spooling server. Communicating the directory to the printer polling device; presenting the directory at the printer polling device; providing for selection of a print job from the directory (col. 1, lines 43-53).

As to claim 38, Newton teaches that the client device periodically polls the spooling server (col. 1, lines 48-53).

As to claims 50 and 80-83, combination of Motegi, Savitzky and Newton teaches the apparatus for performing the method claims 5, 35-38.

4. Claims 7-11 and 52-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Motegi, Savitzky and Ikeda, in view of claims 1 and/or 46, and Pearson (US Patent No. 6,023,684).

As to claim 7, Motegi and Savitzky teach every feature in claim 1. Furthermore, Savitzky teaches communication between any the computers (nodes) can occur on the Internet so long as both computers are connected somewhere to the Internet which refers to a global internetwork of networks (col. 1, lines 12-17).

However, neither Motegi nor Savitzky teach the printer polling device is located within a gateway firewall; and the spooling server is located outside the gateway firewall.

Pearson, in the same field of endeavor, teaches the printer polling device (any of computers in the network) is located within a gateway firewall; and the spooling server is located outside the gateway firewall (col. 5, line 54 to col. 6, line 1; col. 7, lines 33-39 and col. 10, lines 32-35).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the communication system of Motegi, Savitzky and Ikeda in order to the printer polling device is located within a gateway firewall; and the spooling server is located outside the gateway firewall as taught by Pearson. The suggestion for modifying the system of Motegi, Savitzky and Ikeda can be reasoned by one of ordinary skill in the art as set forth by Pearson because Pearson provides a security system in the network in which the documents of the users in the network are filtered by a proxy firewall. The resultant system of Pearson would allow any document of Savitzky or Chan to be maintained on the security system.

As to claim 8, Savitzky teaches that the print job is forwarded to the spooling server as web-style traffic and received at the printer-polling device as web-style traffic (see HTTP channels in fig. 1).

As to claim 9, Newton teaches that the print job is forwarded to the spooling server such that reconfiguration of the gateway firewall is not required (col. 6, lines 10-13).

As to claim 10, Savitzky teaches that a print job source is located at and in communication with a first LAN and forwards the print job to the spooling server; the printer polling device is located at and in communication with a second local area network; and the spooling server is located outside of the first and second LANs (col. 1, lines 12-17).

As to claim 11, Newton teaches that the print job source communicates with the spooling server via a first gateway firewall which controls access to the first LAN; and the printer polling device communicates with the spooling server via a second gateway firewall which controls access to the second LAN (col. 5, line 54 to col. 6, line 1; col. 7, lines 33-39 and col. 10, lines 32-35).

As to claims 52-56, combination of Motegi and Savitzky and Pearson teaches the apparatus claims for performing the method claims 7-11.

Response to Arguments and Amendment

Applicant's arguments filed 11/06/03 have been fully considered but they are not persuasive.

The new cited reference of Ikeda for the added new limitation of polling request being automatically forward from the printer polling device to the spooling server (please see the solution).

Motegi also discloses the limitations of claim 1 and 46 that forwarding the print job to a spooling server (i.e., the host computer 113 in fig. 1) (col. 2, lines 57-60: the network computer forwarding the print jobs from computers to the host computer 113); receiving and storing the print job at the spooling server (the host computer stores the print jobs from the users 101 to 104 until requesting from the user in step of S2 in fig. 3); receiving an instruction at the spooling server to initiate the print job for printing at a designated printer (the selected printer is controlled by the user "col. 2, lines 60-62". Therefore, the print job including the designated printer setting is sent by the user; and the print job is initiated by the host computer with the password to the

user, the user does not assign the password col. 3, lines 19-24); initiating the print job for printing in response to the instruction (the host computer provide the confidential information by providing the password to the print job "col. 3, lines 48-50"); receiving a polling request for the initiated print job at the spooling server from a printer (i.e., a printer 107 in fig. 1) via a printer-polling device associated with the designated printer (col. 3, lines 33-37: the print server sends the polling request by the printer for the initiated print job to the host computer); forwarding the request initiated print job from the spooling server to the printer-polling device in response to the polling request from the printer (col. 3, lines 3, lines 51-52). Only teaching of Savitzky would modify to the deficiency of Motegi that a computer (i.e., client A) in the network requests for a document file from the spooling server (i.e., the agency 32 in fig. 3) and receives the requested document from the agency (i.e., client A is recipient who sends the document requests, col. 10, lines 33-34 and 51-52).

Applicant asserted in the previous argument that " Newton does teach how to use polling to retrieve " message" such as email, but does not teach to use the polling method in the printing application. Further Newton does not teach that such polling would be applicable in combination with other techniques for the application of networked printing." In reply, Newton teaches the documents (i.e., a message in email) stored in the server and a client (i.e., the printer polling device) for periodically polls the server to identify print jobs associated with the printer polling device (col. 1, lines 43-55 describes that the messages in email are stored on the server as files and then transmitted to clients operated by intended recipients as files). Therefore, the files requested by a client and can be printed at the client side.

Applicant asserted in previous argument that " In contrast, the present invention is directed at ease of deployment on the local client network behind the proxy/firewall (see "B" in the diagram)). In reply, Pearson teaches the firewall or the security is provided to the client (col. 5, lines 61-65 describes that Client messages which are in the format of a known internet service, such as email, FTP are delivered to a proxy firewall before being delivered to the server which supports the Internet services; and also, col. 10, lines describes that Firewall 54 permits customer service computers 52 which are coupled together through a computer network to utilize Internet services, such as email, WWW, FTP, Telnet, Rlogin and Usenet in a secure manner.). Therefore, the files, which are transferred anywhere in the global internetwork, is secured by Firewall. The communication between devices in the global internetwork is secured by Firewall.).

For the above reasons, it is believed that the cited prior art fully discloses the claimed invention and the rejection stand.

Conclusion

Applicant's amendment with respect to claims 1-96 have been considered but are moot in view of the new ground(s) of rejection. This action is made **non-final**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran
Jan. 24, 2004

Tranlong